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Thomas Jessop

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EXAMINER

POLLOCK, GREGORY A

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/942,453	<b>Applicant(s)</b> JESSOP ET AL.	
	<b>Examiner</b> GREG POLLOCK	<b>Art Unit</b> 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12/08/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-19, 23-34, 45 and 47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-19, 23-34, 45 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is responsive to claims filed 12/08/2009 and Applicant's request for reconsideration of application 09/942453 filed 12/08/2009.

The amendment contains original claims 2-4, 6-12, and 15-19.

The amendment contains previously presented claims 5, 23, and 34.

The amendment contains amended claims 1, 45, and 47.

Claims 14, 20-22, 35-44, and 46 have been canceled.

As such, claims 1-13, 15-19, 23-34, 45, and 47 have been examined with this office action.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-13, 15-19, 23, 34, 45, and 47** are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter. The claims are directed toward the statutory category of a method (process), however based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a statutory § 101 process must (1) be tied to a particular machine or apparatus or (2) physically transform underlying subject matter (such as an article or materials) to a different state or thing. (i.e. "machine-or transformation test"). If neither of these requirements is met by the

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claim, method is not a patent eligible process under § 101 and is rejected as being directed toward non-statutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation in the preamble is insufficient to render an otherwise ineligible method claim patent-eligible. The machine or transformation must impose meaningful limits on the method claims scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. Therefore, reciting a specific machine or a particular transformation of a specific article is an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

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As example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter being transformed, for example by identifying the material being changed to a different state. (Diamond v. Diehr, 450 US 175, 184 (1981); Parker V. Flook, 437 US 584,588 n.9 (1978); gottschalk v. Benson, 409 US 63, 70 (1972); Cochrane v Deener, 94 US 780, 787-88 (1876)). Applicant is also directed to MPEP § 2173.05p, providing guidance with respect to reciting a product and process in the same claim and MPEP § 2111.02 [R3] providing guidance with respect to the effect of limitations within the preamble of a claim.

**In reference to claims**, the claims do not positively recite the other statutory class (thing or product) to which it is tied, by identifying the apparatus that accomplishes the method steps. First, the claims have been amended to include the phrase “via a processor”. Webster's New World College Dictionary, 4th Ed. defines the term “via” as “by means of”. As such the claim limit “selecting via a processor a first corporate entity information type that defines a first corporate entity;” becomes “selecting by means of a processor a first corporate entity information type that defines a first corporate entity;”. A broad and reasonable interpretation of the claim limit is that a processor is used, but that the action of

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the claim limit (selecting) can be interpreted as a human using a computer (processor). Even if the phrase “via a processor” is interpreted as the processor performing the action, based on the applicant’s arguments this does not appear to be a core/central part of what the applicant invented. Additionally, claim 1 includes the nominal recitations of a “processor-implemented” method. However the remaining limits of claim 1 do not recite what structural apparatus is performing the method steps. Therefore, it is unclear what is performing these method steps and as such it is broadly interpreted to encompass all means by which the claim limit can be performed (including a purely mental step performed by a human). To resolve this deficiency, it must be made clear what underlying apparatus is used to perform each recited method step, particularly those that are considered a core/central part of what the applicant invented. **Additionally, merely stating the underlying apparatus in the preamble is not sufficient.** Further, if the method step is performed by software, it must be made clear that the software resides on a physical media and when read by a processor executes the method steps (all of which requires support in the specification). It is recommended that the claim be amended to clarify which method steps are performed by automatically by code and which required human decisions or action.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-13, 15-19, 23, 34, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guheen et al. (U.S. Patent No. 6721713) in view of Feibush et al. (PGPub Document No. 20020158918) in further view of Rebane (U.S. Patent No. 6078904).

**As per claim 1, Guheen et al. teaches a processor-implemented method, comprising:**

**Selecting via a processor a first corporate entity information type that defines a first corporate entity** ([Figures 1, 10, 11, 18, 27A-F, 29A] [columns 1-2] [columns 7-14]);

**selecting a second corporate entity information type that defines a second corporate entity** ([Figures 1, 10, 11, 18, 27A-F, 29A] [columns 1-2] [columns 7-14]);

**selecting a corporate entity relationship information type that defines a relationship between said first and second corporate entity information types** ([Figures 1, 10, 11, 18, 27A-F, 29A] [columns 1-2] [columns 7-14]);

**displaying said corporate entity identity and said corporate entity relationship information types in a graphical user interface view with predetermined indicia, the indicia graphically providing an indication of a connection between said first and second corporate entity information types** ([Figures 1, 8, 10, 11, 16, 18, 23B, 27A-F, 29A] [columns 1-2] [columns 7-14]);

**providing an alteration mechanism wherein the alteration mechanism dynamically changes an information type, chosen from the group comprising corporate entity, corporate entity relationship, selection, grouping, arrangement and view type to be displayed in said graphical user interface view** ([Figures 21C, 27A-F, 29A] [columns 1-2] [columns 7-14] [column 29]).

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Guheen et al. discloses comparing of the strengths and weaknesses of each individual entity ([column 11]). However, Guheen et al. does not explicitly disclose **graphically providing an indication of a strength of the relationship or dynamically changing, using said alteration mechanism, a displayed information type to a newly chosen information type; displaying, simultaneously, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface to facilitate a comparison regarding said first corporate entity and said second corporate entity information types.**

However, Feibush et al. discloses **graphically providing an indication of a strength of the relationship and dynamically changing, using said alteration mechanism, a displayed information type to a newly chosen information type ([Figures 5-7] [pages 1-4]); displaying, simultaneously, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface, wherein the separate display panels facilitate a comparison regarding said first corporate entity and said second corporate entity information types ([Figures 4-7] [¶30-33]).**

It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of comparison displays based on running scenarios for analysis, comparison and patterns regarding relationships between entities as disclosed by Feibush et al. with the method of pictorially displaying alliances among entities as disclosed by Guheen et al.. The motivation would be to use commonly known techniques in the field of computer technology to provide multiple views within one screen to provide a means of making side-by-side visual comparisons.

Guheen et al. and Feibush et al. do not teach **determining at least one pattern between said first and said second corporate entity information types based on the comparison; and constructing a financial product based on said selected and displayed information types and said determined at least one pattern.**

Rebane teaches *inter alia* that an account management module provides a user interface to one or more online investment systems, such as a brokerage house to access and update an investor's account. The account management module retrieves and displays securities data, corporate financials, market performance data and other research information. The account management module also provides for individual trades in the investor's accounts, and transfers the list of current buy/sell order to the investor's investment account for execution. The communications interface gateway provides an interface to external databases



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containing securities data, such as corporate financial data, industry performance, securities price and performance data, investment advisor opinions and consensus ratings, and the like, including, in some versions, more comprehensive portfolio management services without the portfolio analysis and optimization functions as provided by the present invention, as commonly available from brokerage houses, investment firms, and other sources. [column 11]. The investor specifies predicted future performance data for each investment asset. The future performance data may be the alpha, beta, sigma, R2, and cross correlations related to the Efficient Market Hypothesis approach or derived from any other predictive theory, including estimates that may be available in the securities database, information from investment advisors, or inputs which just reflect the investor's own assessments of the future performance of the investments. Regardless of the Market Hypothesis used, the short list maker module computes and updates a covariance matrix for the list [column 12, lines 39-59] (applicant's **determining at least one pattern between said first and said second corporate entity information types based on the comparison**. Also see [Figure 10] [columns 17-18, Section 5.4.4 Correlation Matrix]). Rebane further teach **constructing a financial product based on said selected and displayed information types and said determined at least one pattern** ([Title] [Abstract] [column 12, lines 28-46]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the invention of Rebane with that of Guheen et al. and Feibush et al. to achieve the claimed invention. Guheen et al. provides a system and method for identifying alliances among a plurality of business entities in components of a network framework [Abstract], which can be combined with Feibush et al. to depict a more detailed flow diagram showing data representing objects, events, and correlations that are classified to produce a taxonomy. Each object being a tangible entity that occupies a physical location or region in space and has a state with multiple attributes associated therewith, where each object can stand alone without any link to other entities in the correlation graph. [¶19]. The graphical correlation data of Feibush et al. is stored [Abstract] [¶7] such that the invention Rebane could retrieve and use such data as part of its user interface when constructing and optimizing an investment portfolio. Therefore, since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Indeed, any number of prior art references can be combined with Guheen et al. and Feibush et al. to construct a portfolio from the performance data (applicant's patterns and/or critical path) to accomplish the claimed invention. The examiner has listed a few other examples of prior art made of record and not relied upon in the Conclusion section of this office action which could also be used to generate a portfolio using data acquired from the interface of the combined inventions of Guheen et al. and Feibush et al.

**As per claims 2-13**, the rejection of claim 1 has been addressed.

Guheen et al. teaches **predetermined corporate entity information chosen from the group comprising corporate entities and corporate information; the group comprising buyer-seller relationships, customer-supplier relationships, company-client relationships, parent company-subsidary relationships, ownership relationships, resource sharing relationships, joint ventures, political/business relationships, competitor relationships, value chain relationships, horizontal and vertical relationships; selection and grouping information chosen from the group comprising stocks, bonds, financial instruments, sectors, industry segments, SIC codes, and product lines; arrangement information chosen from the group comprising column, row, grid, map, free-form, and structured; view type information chosen from the group comprising fundamental information, market risk information and performance information ([Figures 1, 8, 10, 11, 14, 16, 17, 18, 21C-F, 23B-F, 27A-F] [columns 1-2] [columns 7-14]).**

**As per claims 15-19**, the rejection of claim 1 has been addressed.

Guheen et al. teaches **corporate entity and corporate relationship indicia are chosen from the group comprising graphic, audio, video; graphic and corporate entity relationship indicia chosen from the group comprising color, pattern and shape ([Figure 1, 11, 16, 22, 27A- F, 94] [columns 1-2] [columns 7-14]).**

**As per claim 23**, the rejection of claim 1 has been addressed.

Guheen et al. teaches that **alteration mechanism is chosen from the group comprising pointing device input, keyboard input and voice input ([column 23]).**

**As per claim 34**, the rejection of claim 1 has been addressed.

Guheen et al. and Feibush et al. do not teach a method **wherein the financial product is chosen from the group comprising market baskets of financial instruments, structured products, financial indices and mutual funds.**

Rebane teaches a method **wherein the financial product is chosen from the group comprising market baskets of financial instruments, structured products, financial indices and mutual funds ([column 8, lines 6-23]).**

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the invention of Rebane with that of Guheen et al. and Feibush et al. to achieve the claimed invention. Guheen et al. provides a system and method for identifying alliances among a plurality of business entities in components of a network framework [Abstract], which can be combined with Feibush et al. to depict a more detailed flow diagram showing data representing

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objects, events, and correlations that are classified to produce a taxonomy. Each object being a tangible entity that occupies a physical location or region in space and has a state with multiple attributes associated therewith, where each object can stand alone without any link to other entities in the correlation graph. [¶19]. The graphical correlation data of Feibush et al. is stored [Abstract] [¶7] such that the invention Rebane could retrieve and use such data as part of its user interface when constructing and optimizing an investment portfolio. Therefore, since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**As per claim 45**, the rejection of claim 1 has been addressed.

Guheen et al. teaches **providing another information type, chosen from the group of government entities, government information, financial entities, financial information, industry information, industry segment information, sector information, index information, personal entities and personal information, that may be displayed in said graphical user interface view, selected by said alteration mechanism, and related to the other information types by said indicia** ([Figures 1, 8, 10, 11, 14, 16, 17, 18, 21C-F, 23B-F, 27A-F] [columns 1-2] [columns 7-14] [column 23]).

**As per claim 47**, All of the limits of Claim 47 have been previously addressed in Claims 1-13, and is therefore rejected using the same prior art and rationale.

### ***Response to Arguments***

6. Applicant's arguments with regards to claims 1-13, 15-19, 23-34, 45, and 47, filed 12/08/2009 have been fully considered but they are not persuasive.
7. APPLICANT REMARKS CONCERNING Claim Rejections - 35 USC § 112 (page 8-12): The applicant contends that the prior 35 USC § 112 1<sup>st</sup> rejection for enablement and the 35 USC § 112 2<sup>nd</sup> rejection for omitted structural cooperative relationships of elements should be vacated based on the applicant's disclosure.

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8. EXAMINER'S RESPONSE: EXAMINER'S RESPONSE: The examiner vacates the 35 USC § 112 1<sup>st</sup> and 2<sup>nd</sup> rejection in favor of a broad interpretation of claim limits. The applicant is reminded that the specification is given its broadest reasonable interpretation in light of the specification, but not to import the specification into the claim limits. For method claims, each claim limit is evaluated to determine what is performing the action of each step. A method step which does not state what is performing the action is given its broadest reasonable interpretation to include a human performing the action.
9. APPLICANT REMARKS CONCERNING Claim Rejections - 35 USC § 101: The applicant contends that that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP § 2106, Section IV, states "claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection." MPEP § 2106 also discusses "[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be." Applicants submit that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature. Although Applicants respectfully traverse the Examiner's rejection and reserve

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the right to argue patentability of the claims in their original form at a later time, Applicants have amended independent claims 1 and 47 to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices. Independent claim 1 recites a "A processor- implemented method, comprising: selecting via a processor .... " Similarly, independent claim 47 recites "A processor-implemented method, comprising: ... receiving via a processor .... " As such, Applicants submit that independent claims 1 and 47 are directed to statutory subject matter.

10. EXAMINER'S RESPONSE: The examiner respectfully disagrees with the applicant's arguments. As stated in the Claim Rejections - 35 USC § 101 section of this office action, the claims do not positively recite the other statutory class (thing or product) to which it is tied, by identifying the apparatus that accomplishes the method steps. First, the claims have been amended to include the phrase "via a processor". Webster's New World College Dictionary, 4th Ed. defines the term "via" as "by means of". As such the claim limit "selecting via a processor a first corporate entity information type that defines a first corporate entity;" becomes "selecting by means of a processor a first corporate entity information type that defines a first corporate entity;". A broad and reasonable interpretation of the claim limit is that a processor is used, but that the action of the claim limit (selecting) can be interpreted as a human using a computer (processor). Even if the phrase "via a processor" is interpreted as the processor performing the action, based on the applicant's arguments this does not appear

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to be a core/central part of what the applicant invented. Additionally, claim 1 includes the nominal recitations of a “processor-implemented” method. However the remaining limits of claim 1 do not recite what structural apparatus is performing the method steps. Therefore, it is unclear what is performing these method steps and as such it is broadly interpreted to encompass all means by which the claim limit can be performed (including a purely mental step performed by a human).

11. APPLICANT REMARKS (page 10-15): Applicants states that Applicants reiterate that Feibush was filed March 27, 2002, after Applicants filing date of August 30, 2001, and that Feibush claims priority to Provisional Application No. 60/333,112 which was filed on March 28, 2001, less than six months earlier than Applicants filing date of August 30, 2001 and it is not conceded that Feibush was filed in the US before the invention by the Applicants.

Without so conceding, Applicants respectfully traverse the Examiner's rejection.

Applicants further note that in the pending rejection, the Examiner cited Figures 4-7 of Feibush, and alleges that

Feibush et al. discloses ... **displaying, simultaneously, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface to facilitate a comparison regarding said first corporate entity and said second corporate entity information types** ([Figures 4-7] [¶ 30-33]...)

(pp. 10-11, Office Action; emphasis original)

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Applicants submit that Figures 4-7 of Feibush are not contained in Provisional Application No. 60/333,112 filed on March 28, 2001, the document to which Feibush claims priority, as discussed above. As such, Applicants submit that a *prima facie* case of obviousness has not been established by the Examiner over the currently cited references.

12. EXAMINER'S RESPONSE: The examiner respectfully disagrees with the applicant's arguments. First, the fact that Feibush was filed March 27, 2002, after Applicants filing date of August 30, 2001, less than six months earlier than Applicants filing date of August 30, 2001 does not disqualify Feibush as prior art. Second, the Provisional Application No. 60/333,112 filed on March 28, 2001 drawing numbering is not the same. However, Figures 4(a) – 4(c) with accompanying description still describe that which the examiner has relied upon for rejection of claims.
13. APPLICANT REMARKS (pages 15-19): The applicant contends that the pending rejection has mischaracterized the claim elements and over-generalized the cited references. Applicants submit that none of the Examiner's cited portions of Rebane (U.S. Patent No. 6078904) discusses or renders obvious at least the claimed "determining at least one pattern between said first and said second corporate entity information types based on the comparison" as recited in independent claim 1.

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14. Instead, the Examiner's cited portions of Rebane, column 12 lines 39-59, simply discuss generating/retrieving short lists of investor assets used by a user to evaluate risk. For example, Rebane discusses, "[f]or each short list, the investor specifies predicted future performance data for each investment asset" (col 12, lns 49-50, Rebane). Rebane also discusses "the short list maker module 311 computes and updates a covariance matrix for the list" (col 12, lns 58-59, Rebane). The Examiner's cited portions of Rebane, Figure 10 and column 17-18, discuss a screen display "representing a modified correlation matrix of risk adjusted returns for a portfolio of candidate securities" (Figure 10, col 17, lns 12-14, Rebane), and discuss that "this screen display 1000 enables the investor/analyst to quickly get the 'feel' for how RDAA module 301 determines portfolio membership", and the "feedback" is considered by an investor to add "new investments to a portfolio" (col 17, lns 34-40, Rebane). However, having provided a "short list" of "investment asset[s]" for risk evaluation, Rebane does not discuss any type of comparison in generating the "short list" or "covariance matrix." As such, Applicants submit Rebane's short list display is different from the claimed "determining ... at least one pattern between said first and said second corporate entity information types based on the comparison" as recited in independent claim 1.
15. EXAMINER'S RESPONSE: The examiner respectfully disagrees with the applicant's arguments. The basis of the applicant's argument appears to be that "Rebane does not discuss any type of comparison in **generating** the "short list"



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or "covariance matrix.". However, as the applicant points out in the next paragraph on page 18 "The MPEP prescribes that, "when evaluating the scope of a claim, every limitation in the claim must be considered," [§ 2106 II(C), emphasis added] and, "All words" in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added].". The claim limit clearly states "**determining**" (not generating) at least one pattern between said first and said second corporate entity information types based on the comparison". The cited section of Rebane clearly shows the claim limit of "determining".

16. Therefore, in view of the above reasons, Examiner maintains rejections.

### **Conclusion**

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pollock whose telephone number is 571 270-1465. The examiner can normally be reached on 7:30 AM - 4 PM, Mon-Fri Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chuck Kyle can be reached on 571 272-5233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GAP

02/27/2010

/Gregory Pollock/  
Examiner, Art Unit 3695

Gregory A. Pollock

/Thu Thao Havan/  
Primary Examiner, Art Unit 3695